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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,601	11/01/2001	Ulrike Rohr	2000DE135	8200

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INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT PAPER NUMBER

1756

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,601

Applicant(s)

ROHR ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16,18-20,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16,18-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Claim Rejections - 35 USC § 112***

Claims 1, 2, 4-16, 18-20, and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection was presented in the last Office action. As noted there, the specification as filed does not disclose the claimed process steps (e.g., homogeneously incorporating, grinding, and classifying as specified) for the production of a liquid toner. The current claims method steps were specifically based on the production of a dry toner (See Examples 4-6; discussion in Office action of 28 March 2003 pp. 2-3; response of 27 May 2003 pp. 7-8 & 11-12). A review of the specification does not disclose the currently recited method steps for formation of a liquid toner.

Applicants traverse this rejection because "homogeneously incorporating" is recited for both liquid and dry toners in ¶ [0079]. Further, the disclosure of Example 4, according to applicants, is not limited to "dry binders". Depending on the physical state of the toner binder the resulting electrophotographic toner will be either a dry powder or a liquid. The term "toner binder" is used in Example 4 rather than a binder resin. The specific binder used in Example 4 is a polyester resin. Applicants take the position that "toner binder" includes all kinds of toner binders, such as solids, liquid hydrocarbons, and liquid aqueous systems. From this applicants conclude that the artisan would readily understand that the mixture (liquid or dry) is ground and

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classified. Applicants conclude that the requirements of section 112, first paragraph, have been met.

Specification ¶ [0079] states, "The coated pigment granules used in accordance with the invention are homogeneously incorporated, by extrusion or kneading, for example, or added during its polymerization process, into the binder of the respective toner (liquid or dry), developer, ..." This passage clearly states that the coated pigment granules are homogeneously incorporated into the binder resin of the liquid or dry toner developer. Contrary to applicants' position, however, the specification does not teach that the binder of the liquid toner can be a liquid. The liquid portion of a liquid toner or developer is typically referred to as a dispersant or carrier liquid while the resin portion of the liquid toner or developer is referred to as a resin (see Diamond, Arthur S. (ed.) *Handbook of Imaging Materials*, pp. 231-233, enclosed). As noted in the Diamond text, the resin is usually in the form of resin particles having the colorant therein (p. 231). These resin particles are then dispersed in the dispersant to form a colloidal dispersion. There is no indication in the specification or in the art of record that the toner binder of a liquid developer is the dispersant.

Example 4 is specifically directed to the formation of a dry toner. No liquid is present in this example and the artisan would not recognize the specific process steps referenced in this example as relating to the formation of a liquid toner because there are no liquid components present. The term "toner binder" in Example 4 clearly refers to a resin because it is defined as a polyester resin. Further, this toner binder is for a dry toner noting the formation of particles in the example that are present without a liquid.

The combination of process steps taught by the specification is limited to the production of dry toners. The specification as filed does not disclose the combination of process steps for formation of liquid toners.

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The rejection is still seen as proper and is maintained.

Allowable Subject Matter

Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 23 is understood to limit the composition to a dry toner. Any amendment inserting the limitations of claim 23 into claim 1 must reflect this position.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
8 July 2005



CHRISTOPHER RODEE
PRIMARY EXAMINER